

REMARKS

Claims 1-18 are currently pending in the Application. In the Office Action, it was asserted that the Application contains claims which are directed to distinct inventions. As a result, the Examiner issued a Restriction Requirement requiring the election of a single group of claims for prosecution.

The claims, as grouped by the Examiner, appear as follows:

- I. Claims 1 and 18, drawn to compounds, classified in class 568, subclass 719.
- II. Claims 2-11, drawn to processes using an alkene reactant, classified in class 568, subclass 719.
- III. Claims 12-14, drawn to processes using a halide reactant, classified in class 568, subclass 719.
- IV. Claims 15 and 16, drawn to processes using sulfonate reactant, classified in class 568, subclass 719.
- V. Claim 17, drawn to a process using an alcohol reactant, classified in class 568, subclass 719.

Applicants respectfully traverse the Restriction Requirement.

The Examiner states that the inventions are distinct from each from the other because the claims of Groups I and II, III, IV or V are related as process of making and product made. According to MPEP § 806.05(f), the inventions are distinct if it can be shown either that (1) the process as claimed can be used to make other and materially different products, or (2) the product can be made by another and materially different process. The Examiner asserts that the processes can be used to make compounds outside of the claims of Group I and that the claims of

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Groups II-V evidence that the product may be prepared by more than one process. Office Action at pg. 2.

Under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP § 803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP § 803. Here, all five groups of claims are all classified in the same class and subclass: class 568, subclass 719. Thus, Applicants respectfully submit that a search of patent documents would not constitute a serious burden on the Examiner.

The Examiner asserts that despite identical classification, the search would require a divergent search of the literature. Office Action at pg. 3. However, Applicants note that in addition to the same classification, all groups of claims contain a common reactant (5,5',6,6',7,7',8,8'-octahydro-2,2'-binaphthol). Furthermore, the claims of Groups II-V include the limitation of an acid catalyst. Thus, Applicants submit that even a literature search would not be as burdensome as suggested by the Examiner.

Applicants respectfully submit that a five-way restriction is a severe measure, particularly in light of the limited number of claims (18) and the overlapping nature of the subject matter as demonstrated by the identical classifications of all five groups of claims. In light of the foregoing, Applicants respectfully request the Examiner reconsider the Restriction Requirement.

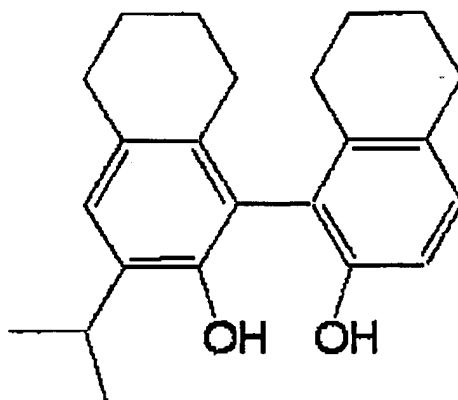
Notwithstanding the above, in order to comply with the Restriction Requirement, Applicants elect with traverse the claims of Group I. Applicants further request that the

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remaining claims be held in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

The Examiner has further indicated that if the claims of Group I are elected, that Applicants "must provisionally elect a single disclosed and claimed species, i.e. a single compound." Office Action at pg. 3. It is asserted by the Examiner that the members of the Markush groups of claims 1 and 18 are so unrelated and diverse that a prior art reference anticipating the claims with respect to some members would not render the claims obvious under 35 U.S.C. § 103 with respect to all of the other members. *Id.*

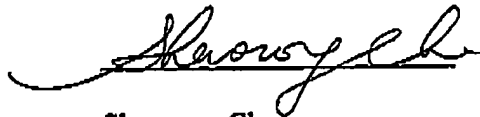
As Applicants have elected Group I, and in light of the cancellation of the species of formula 2 in the Preliminary Amendment, Applicants now provisionally elect the compound of claim 1 designated by formula 1, wherein R is an isopropyl group. The elected compound reads on all of the claims of Group I and has the structural formula as shown:



CONCLUSION

If the Examiner has any questions regarding the election of the claims of Group I or the elected species, the Examiner is invited to contact Applicants' undersigned representative for a telephone conference to resolve such questions in an expeditious manner.

Respectfully submitted,



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